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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/548,235 04/12/00 LEVERGOOD

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EXAMINER

TM02/0731

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WITNER, P

ART UNIT

PAPER NUMBER

2155

DATE MAILED:

07/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No. 09/548,235	Applicant(s) Levergood et al.
Examiner Patrice L. Winder	Art Unit 2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on May 14, 2001

2a)  This action is FINAL.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 1035 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-5 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-5 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

15)  Notice of References Cited (PTO-892)

18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

19)  Notice of Informal Patent Application (PTO-152)

17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4, 5

20)  Other: \_\_\_\_\_

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***Information Disclosure Statement***

1. The information disclosure statement filed May 14, 2001, paper #5, fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

In order to consider, the CompuServe Trend System, Web-Basket and "Creating the Virtual Store" publications applicant would need to provide a copy of each publication.

***Oath/Declaration***

2. This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. The newly claimed subject matter is "charging for advertising based on link traversals to the page" and "measuring the number of sales or transactions resulting from link traversals". A supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

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***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant has not provided a detailed disclosure of “charging for advertising based on link traversals to the page”. The examiner is aware of page 14, line 24 - page 15, line 6 of the disclosure. If there is further detail to applicant’s disclosure please indicate the corresponding areas of the disclosure.

5. Claims 4 and 5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant has not provided a detailed disclosure of “measuring the number of sales or transactions resulting from link traversals”. The examiner is aware of page 14, line 24 - page 15, line 6 of the disclosure. If there is further detail to applicant’s disclosure please indicate the corresponding areas of the disclosure.

6. It is generally understood that the state of the art at the time of the invention as understood by the inventor can be determined by the degree of detail in the disclosure and that

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which is left for one of ordinary skill in the art to perform is presumed to be within the skill in the art to perform. As applicant has supplied no detail enabled of this alleged nonobvious process by which to “charge for advertising based on link traversals to the page” and “measure the number of sales or transactions resulting from link traversals”. Therefore, it is presumed to be within the skill of the art (*In re Fox* 176 USPQ 340).

7. Applicant’s arguments filed on May 14, 2001, paper #5, been fully considered by are not persuasive. As to applicant’s assertion that one of ordinary skill in could readily implement “programs for counting and measuring sales and transactions.” Arguments of counsel alone cannot take the place of evidence (see *In re Budnick*, 190 USPQ 422, 424 (CCPA 1976); *In re Schulze*, 145 USPQ 716 (CCPA); and *In re Cole*, 140 USPQ (CCPA 1964)).

8. It is not enough that a person skilled in the art, by carrying on investigations along the line indicated in the instant application, and a great amount of work eventually find out how to make and use the instant invention. The statute requires the application itself inform, not direct others to find out for themselves (*In re Scarbough*, 182 USPQ 198).

Further as specification us completely absent of any steps or program code required to perform the essential function, (*In re Scarbough*, 182 USPQ 198). Note that the courts have held that the employment of block diagrams and description of their function are not fatal, providing the represented function is conventional and can be determined without undue experimentation (*In re Donohue*, 193 USPQ 137). Applicant has made no admission or showing that the programming required is conventional.

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***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

10. Claims are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al., U.S.

Patent No. 5,982,891 (hereafter referred to Ginter).

11. Regarding claim 1, Ginter taught a method of charging for advertising on the Web, comprising:

determining link traversals leading to a page (col. 288, lines 16-21, col. 287, lines 1-8, relating to product, col. 286, lines 47-57); and

charging for advertising (col. 33, lines 41-58) based on link traversals to the page (link traversals from VDE to remote location, col. 290, line 65 - col. 291, line 2).

12. Regarding dependent claim 2, Ginter taught charging for advertising (col. 33, lines 41-58) is based on the number of link traversals from an advertising page (VDE repository presents listing of products, col. 286, lines 61-66) to a product page (remote location of products, col. 291, lines 2-9).

13. Regarding dependent claim 3, Ginter taught wherein charging for advertising is based on the number of sales resulting from a path including an advertising page (number of sales = number

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of requests for purchased products, col. 24, lines 25-32, col. 142, lines 33-35, col. 143, lines 27-28, VDE repository presents listing of products, col. 286, lines 61-66).

14. Regarding claim 4, Ginter taught a method of evaluating the effectiveness of advertising on the Web, comprising:

determining link traversals (col. 288, lines 16-21, col. 287, lines 1-8, relating to product, col. 286, lines 47-57) leading from an advertisement (VDE repository presents listing of products, col. 286, lines 25-66) to a page (remote location of products, col. 291, lines 2-9); and

measuring the number of sales (number of sales = number of requests for remote products, col. 24, lines 25-32, col. 142, lines 33-35, col. 143, lines 27-28) resulting from link traversals from the advertisement to the page (VDE repository presents listing of products, col. 286, lines 61-66).

15. Regarding claim 5, Ginter taught a method of evaluating the effectiveness of advertising on the Web, comprising:

determining link traversals (col. 288, lines 16-21, col. 287, lines 1-8, relating to product, col. 286, lines 47-57) leading from an advertisement (VDE repository presents listing of products, col. 286, lines 61-66) to a page (remote location of products, col. 291, lines 2-9); and

measuring the number of transactions (number of transactions = number of requests for remote products, col. 24, lines 25-32, col. 142, lines 33-35, col. 143, lines 27-28) resulting from link traversals from the advertisement to the page (VDE repository presents listing of products, col. 286, lines 61-66).

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is (703) 305-3938. The examiner can normally be reached on Monday-Friday from 10:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh, can be reached on (703) 305-9648. The fax phone number for this Group is (703) 308-9052.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



**Patrice Winder  
Patent Examiner  
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